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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,652	04/30/2001	Akihiro Kondo	KONDO 7	1863
1444	7590	11/23/2004	EXAMINER	
BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			CHUNDURU, SURYAPRABHA	
			ART UNIT	PAPER NUMBER
			1637	

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Advisory Action</b>	<b>Application No.</b> 09/830,652	<b>Applicant(s)</b> KONDO ET AL.	
	<b>Examiner</b> Suryaprabha Chunduru	<b>Art Unit</b> 1637	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): rejection under 35 USC 112, second paragraph and claim objections.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.

Claim(s) objected to: none.

Claim(s) rejected: 13-14.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

**JEFFREY FREDMAN**  
**PRIMARY EXAMINER**

11/19/09

Continuation of 5. does NOT place the application in condition for allowance because: Applicants' amendment and the declaration submitted are fully considered and the arguments regarding the rejection under 35 USC 103(a) are found not persuasive. Applicants argue that Wang et al. disclose identifying genes comprising known and unknown genes that are related to a signal transduction pathway and the instant invention is drawn to a method for identifying genes on a DNA array comprising at least one "known" gene for each of the groups (1) to (17). These arguments are found not persuasive for two reasons. First, the instant claims do not recite DNA array comprising "known" genes, and thus the limitation is not in the claims. Further the instant claims recite at least one gene for each of the groups (1) to (17), which indicates that at least one gene could be a known or unknown gene in that pathway. Secondly, Wang et al. teach identifying known genes, in addition to the identification of unknown genes affected by the treatment with TCDD (endocrine disruptor). Thus Wang et al. does teach the identification of known genes. Further the claims are in "comprising" format and any additional steps are permissive, thus Wang et al. does disclose known genes in addition to unknown genes.

Applicants also argue that the combination of Wang et al. in view of Scena would not make the instant invention obvious because Scena does not teach selection of the genes influenced by endocrine disrupting activity and thus can not result in achieving the claimed invention. Applicants arguments are fully considered and found not persuasive because selection of genes influenced by endocrine disrupting activity can be achieved only after analysis of the gene expression pattern upon treatment with an endocrine disruptor thus it is prima facie obvious that the DNA array as disclosed by Scena would lead to the selection of genes since Scena discloses DNA array comprising about 1000 human genes which include genes related to signal transduction pathway and does disclose the differential expression of genes after treatment, which result in selection of genes related to that signal transduction pathway. Thus an ordinary practitioner would have been motivated to modify the method of identifying endocrine-disrupting activity of a test substance as taught by Wang et al. with the incorporation of the DNA array as disclosed by Scena which includes a series of signal transduction pathway genes related to growth, development, differentiation and homeostasis, for the expected advantage of developing an improved method for the characterization of endocrine disrupting test substance(s) and to facilitate in a better screening of a wide variety of the test substances based on monitoring gene expression in a high-throughput assay system to identify the genes related to a signal transduction pathway. Therefore the rejection is maintained herein for reasons discussed above.